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SEP 18 2008

Docket No.: 041-2057C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
Ryota TSUKIDATE	:	Confirmation No. 3199
	:	
Serial No. 10/684,643	:	
	:	Group Art Unit: 2615
Filed: October 15, 2003	:	
	:	Examiner: ONUAKU, Christopher
For: MULTIMEDIA RECORDER WITH ENHANCED EPG-RELATED FUNCTIONS		

Honorable Commissioner of Patents
PO BOX 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT
UNDER 37 CFR 711.03(c)(I)(A) and 37 CFR 1.181(a)**

**FILED BY FACSIMILE 1 571 273 8300
on September 18, 2008**

Sir,

FACTS

1. An Office Action was issued by Examiner Onuaku on November 1, 2007. This action set forth a response period of three (3) that would have expired on February 1, 2008 absent the filing of one or more Petitions to extend this response date. If all extensions of time permitted in this matter were petitioned for and granted, the response period would have been the statutory response period of six (6) months that would have expired on May 1, 2008.

2. The referenced action was addressed to the undersigned attorney at his former address of 5522 Riva Ridge Drive, Wesley Chapel, Florida 33544. This attorney's address had previously been communicated to the Patent Office in a paper filed January 26, 2005. The Patent Office record, as set forth in Public PAIR, acknowledges receipt of this Change of Address form on January 26, 2005.

3. A second Change of Address form was filed in the Patent Office by the undersigned attorney on November 13, 2005. This second Change of Address form communicated the undersigned attorney's new address to be 424 Lantana Park, Lexington, Kentucky 40515. This second Change of Address form is acknowledged to have been received by the Patent Office on November 13, 2005 as set forth in Public PAIR. Therefore, as of November 13, 2005, the undersigned attorney's address for all matters pertaining to this application and the United States Patent Office is and was 424 Lantana Park, Lexington, Kentucky 40515.

4. The referenced action, not having been sent to this Kentucky address, but rather having been sent to the above referenced Florida address was not received by the undersigned attorney prior to July 24, 2008. The first notice that an Office Action had been issued in the above referenced application was received by the undersigned attorney in the form of a telephone call from Examiner Onuaku on July 24, 2008. On July 25, 2008, a copy of the referenced Office Action was made by the undersigned attorney from the official Patent Office record (Public PAIR). A copy of this Office Action, a report of all of the circumstances in this matter and a request that the client provide instructions for responding to this Office Action were sent by FAX to the instant attorney's client on July 25, 2008.

5. On July 25, 2008 a Petition to reinstitute the pendency of the above referenced application was drafted and filed in the Patent Office by FAX. That Petition set forth the facts in this matter in much the same manner as they have been set forth above. The facts set forth in this initial Petition support three (3) possible alternative remedies to this situation:

- A. Withdraw the holding of abandonment based on applicant's failure to receive the referenced Office Action as provided for in 37 CFR 711.03(c)(I)(A);
- B. Revive this application as having been unavoidably abandoned as provided for in 37 CFR 137(a); or
- C. Revive this application as having been unintentionally abandoned as provided for in 37 CFR 1.137(b).

6. On September 8, 2008 the Patent Office issued a decision on the issues raised in the referenced Petition to wit: the Petition to Revive was dismissed subject to the instant applicant filing a further Petition to Revive on either an unavoidable or an unintentional abandonment basis, along with the appropriate fee, within two (2) months from the date of this decision. A further alternative was provided to the instant applicant in the footnote on page 1 of the decision to wit: file a Petition to Withdraw the Holding of Abandonment that carries no fee. The facts set forth above and in the initially filed Petition fully support any and all of these remedies.

DISCUSSION

It is clear that the facts in this matter, both as set forth above and as set forth in the original Petition to Revive, support a final ruling that applicant and the undersigned attorney bear no responsibility for this application having become abandoned for failure to timely respond to the Office Action of November 1, 2007. The Patent Office did not follow its own files that clearly set forth the correct present address of the undersigned attorney. Having failed to follow its own records by sending the referenced Office Action to the wrong address, the Patent Office and not the applicant or his attorney was the cause of applicant failing to respond to the outstanding Office Action in a timely manner. Had the Action been sent to the attorney's address of record, it would have been timely responded to and there would have been no need for the filing of this Petition.

Section 711.03(c)(I)(A) of the MPEP tells us that such a Petition does not require a fee. However, it does require a statement from a practitioner stating that the Office communication was not received. The undersigned attorney has made this statement in the original Petition that was filed in this matter. The undersigned attorney reiterates this statement in the instant renewed Petition. **Neither applicant nor the undersigned attorney received the Office Action of November 1, 2007 prior to July 24, 2008.**

The MPEP section requires that a search of the file jacket and of the docket record of the undersigned attorney be carried out to insure that, indeed the Office Action was not received.

While such a search might be warranted in some circumstances, in the instant matter it is clear from the Patent Office record itself that neither applicant nor the undersigned attorney could have received the Office Action as it was sent to an address where neither the applicant nor the attorney resided or carried out any business at the time that the Office Action was issued or at any other time since November 1, 2007. Copies of the undersigned attorney's docket records prior to July 24, 2008 would only produce blank sheets of paper for this application. There was nothing to record as the referenced Office Action was sent to the wrong address and not received. The undersigned attorney can and does attest to the fact that the referenced Office Action was not received prior to July 25, 2008 and that no docket record exists showing that the instant Office Action was received prior to July 25, 2008 when a copy of the Office Action was retrieved from PAI by the undersigned attorney.

It is also recognized that to support either a Withdrawal of a Holding of Abandonment or a Petition to Revive it is necessary that a complete response to the Office Action of November 1, 2007 must be submitted. Such a response is attached hereto and made a part of the instant Petition.

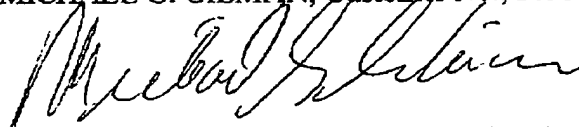
As noted above, a Petition to Withdraw a Holding of Abandonment requires no fee. Therefore, no fee is being filed herewith. However, it is recognized that if the instant Petition is considered to be in effect a Petition to Revive an unavoidably abandoned application, or an unintentionally abandoned application, there are fees that become due. While it is not believed that any fee is due in the instant matter, in the event that the Patent Office disagrees with this position and holds that a fee is due, it is requested that such fee be debited from the undersigned attorney's deposit account 50-3406.

It is urged that this matter be considered with significant urgency. The Patent office has recognized that this application has been pending for over 57 months (see page 3 of the recent Decision on Petition). Therefore, this application should be given priority prosecution status.

As noted above, a response to the outstanding Office Action is attached hereto as are copies of the two Change of Address forms that are of interest in this matter. Should the

examiner or the attorney acting on Petitions wish to discuss this matter further, the undersigned attorney is prepared to discuss this matter at their convenience. The attorney's signature below attests to the fact that this Petition has been filed in the Patent Office on the date set forth.

Respectfully submitted,
INTELLECTUAL PROPERTY LAW OFFICE of
MICHAEL G. GILMAN, Customer No.; 50955



Michael G. Gilman, Registration No. 19,114
Attorney for the applicant

Attachments:

424 Lantana Park
Lexington, KY 40515

Phone 859 272 0149
FAX 859 272 0150
Docket No. 041-2057C

September 18, 2008



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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MICHAEL G. GILMAN, P.C.
424 LANTANA PARK
LEXINGTON KY 40515

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SEP 08 2008

OFFICE OF PETITIONS

In re Application of	:	
Tsukidate	:	
Application No. 10/684,643	:	DECISION
Filed 15 October, 2003	:	
Attorney Docket No. 041-2057C	:	

This is a decision on the petition, filed on 25 July, under 37 C.F.R. §1.137(a)¹ for revival of an application abandoned due to unavoidable delay.

The petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)."

Petitioner's alternative is to file a petition under 37 C.F.R. §1.137(b), discussed below.

This is not a final agency action within the meaning of 5 U.S.C. §704.

¹ A review of the extensive discussion at/in the guidance set forth in the commentary at MPEP §711.03(c)(1)(A) and (B) might suggest that the factual averments set forth in the instant petition may be appropriate for a petition (no fee) to withdraw the holding of abandonment and consideration under 37 C.F.R. §1.181. However, Petitioner's failure to seek relief timely under the rule (within two (2) months of the action complained of (Notice of Abandonment) leaves Petitioner with a petition to revive under the provisions of 37 C.F.R. §1.137(a) or (b) as the proper route to obtain a return to pending status for the instant application.

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As to Allegations of
Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It is noted from the outset that Petitioner's papers are problematic, *inter alia*, in that the relief alternatives that Petitioner seeks appear to be several and the showing(s) that Petitioner submits are not fully and separately set forth as required under the Rules of Practice. (37 C.F.R. §1.4(b).)

Petitioner entitles the instant petition as one "[t]o [r]evive," however, Petitioner seeks relief under two separate provisions of the regulation—i.e., 37 C.F.R. §1.137(a) and §1.137(b), with the specifics of the request as to the latter left to little more than authorization of fees. Moreover, Petitioner seems to seek other relief for which a fee might not be required. Yet Petitioner is unspecific as to those details and fails to approach the matter as set forth by the guidance in the Commentary in the Manual of Patent Examining Procedure at MPEP §711.03(c) as to any of these alternatives. Such an approach is inconsistent with the duties outlined in *ex parte Pratt*.²

It is not proper for Office to attempt to guess at or otherwise interpret Petitioner's wishes as to relief sought herein, and the Office will not do so. Rather, the Office will limit this review to the provisions of 37 C.F.R. §1.137(a)—and the Office acts on the authorization to charge Deposit Account 50-3406 for that necessary fee.

The Office will not follow out at this writing Petitioner's generalized authorizations to charge additional fees for alternative form(s) of relief that may not be necessary.

Petitioner again is reminded that each transaction should be set forth in a separate paper as provided under the Rules of Practice. (37 C.F.R. §1.4(b) and (c).)

Rather, the Office notes that the requirements for a petition under the provisions of 37 C.F.R. §1.137(a) are set forth above (and in the regulation as well as in the discussion at available at MPEP §711.03(c), both of which are available online at the Office website (www.uspto.gov), and those requirements include not only the petition, fee and showing of unavoidable delay, but also the required reply to the Office action to which Petitioner failed to respond. This requirement remains outstanding as of this writing. Petitioner further is reminded that the

² *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Matullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

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appropriate forms for petitions under 37 C.F.R. §1.137(a) and (b) are available online as well at the Office website (www.uspto.gov). (Copies are enclosed herewith.)

Petitioner argues that the Office failed to track his series of Notices of Change of Address, and the Office notes that the substance of Petitioner's 13 November, 2005, Notice as to mailing address now has been entered.

Petitioner also is reminded that a practitioner/applicant who obtains a Customer Number and associates his/her/their application(s) with that Customer Number—as set forth in the MPEP and the Office website—may then be able to review at any time and online the status and condition of the their application(s), and so ease the diligence burden upon a practitioner/applicant as to attention to his/her/their applications under prosecution before the Office.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action (copy enclosed herewith) mailed on 1 November, 2007, with reply due absent extension of time on or before 1 February, 2008.

The instant application went abandoned by operation of law after midnight 1 February, 2008.

The Office mailed the Notice of Abandonment (copy enclosed) on 3 July, 2008.

Petitioner filed the instant petition on 25 July, 2008, averring inter alia, nonreceipt, but failing to provide documentary support (e.g., a copy of the docket record/file jacket cover for the instant application and discussion of Petitioner's docketing and calendaring system and a copy of the reply due-date calendar in support of the averments, as discussed at MPEP §711.03(c)).

Petitioner argues that the Office failed to track his series of Notices of Change of Address—the substance of Petitioner's 13 November, 2005, Notice as to mailing address now has been entered.

The Office notes that the requirements for a petition under the provisions of 37 C.F.R. §1.137(a) are set forth above, in the regulation and at MPEP §711.03(c). Those requirements include not only the petition, fee and showing of unavoidable delay, but also the required reply to the Office action to which Petitioner failed to respond, and this requirement remains outstanding as of this writing.

(It is noted that roughly during some fifty-seven (57) months between the date of deposit of the instant application the filing of the instant petition, Petitioner filed one Status Inquiry as to the instant application.)

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Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

The availability of applications and application papers online to Petitioners/practitioners who diligently associate their Customer Number with the respective application(s) now provides practitioners on-demand information as to events/transactions in an application.

As to Allegations of
Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) have not been satisfied as of this writing in that Petitioner failed to submit (the documentary showing and) the reply required.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(a) is dismissed.

ALTERNATIVE VENUE

Petitioner may file a petition under 37 C.F.R. §1.137(b) and aver unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional" (the statement is in the form available online), and a terminal disclaimer and fee where appropriate.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(Petitioner obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Application No. 10/684,643

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: (571) 273-8300
Attn: Office of Petitions

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of Petitioners or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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Docket No.: 041-2057C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Ryota TSUKIDATE

: Confirmation No. 3199

Serial No. 10/684,643

: Group Art Unit: 2615

Filed: October 15, 2003

: Examiner: ONUAKU, Christopher

For: MULTIMEDIA RECORDER WITH ENHANCED EPG-RELATED FUNCTIONS

Honorable Commissioner of Patents
PO BOX 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE

FILED BY FACSIMILE 1 571 273 8300

During a recent telephone conversation with the above referenced examiner, it was called to my attention that an office action had been issued in the referenced application more than six (6) months ago and that, because that action had not been responded to, the instant application was considered to be abandoned. The examiner advised the undersigned attorney that the referenced office action had been mailed to the address of record in this application and that the above referenced examiner had unsuccessfully tried on several occasions to get into telephone contact with the undersigned attorney. This is inconsistent with the facts as set forth below.

This application was filed on October 15, 2003.

The Power of attorney filed with the instant application indicated that correspondence should be sent to Low Hauptman Gilman & Berner at 1700 Diagonal Road, Alexandria, VA 22314. On January 26, 2005 this first correspondence address was changed by, informing the Patent and Trademark Office in writing that the undersigned attorney's new address was 5522

It is recognized that 37 CFR 1.137(a)(2) requires the filing of a Petition fee in matters of this nature. It is believed, however, that since the abandonment was wholly the fault of the Patent Office, a petition fee should be waived. If this contention is in error, kindly debit the petition fee of \$500 set forth by 37 CFR 1.17(l) to the undersigned attorney's deposit account 503406 and advise the undersigned attorney of this action. Should it be decided that the instant abandonment was not unavoidable but rather was unintentional, it is requested that the fee of \$1,500 provided for in 37 CFR 1.17(l) be debited from the above identified deposit account.

It is recognized that 37 CFR 1.137(a)(4) speaks to the filing of a Terminal Disclaimer. It is believed that such a terminal disclaimer would be inappropriate in the instant application as the delay in issuance of the instant patent caused by the failure to timely respond to the outstanding office action was due wholly to the actions of the Patent Office. In fact, any such delay should be favorably considered when determining whether the term of such a patent should be extended. However, should it be decided that a Terminal Disclaimer is appropriate in this matter, the undersigned attorney should be so advised and a Terminal Disclaimer will be provided.

In determining this matter, consideration should be given to the following listed documents submitted herewith:

Correspondence address change filed January 26, 2005; and

Correspondence address change filed November 13, 2005

Respectfully submitted,

INTELLECTUAL PROPERTY LAW OFFICE of

MICHAEL G. GILMAN


Michael G. Gilman

424 Lantana Park

Lexington, KY

Telephones:

Voice: 859 272 0149

FAX: 859 272 0150

Mobile: 301 704 4816

July 25, 2008

Attachments

Riva Ridge Drive, Wesley Chapel, FL 33544. Receipt of this document is acknowledged in the listing of documents in PAIR.

On November 13, 2005 a second correspondence address change was filed, informing the Office that the undersigned attorney's new address was 424 Lantana Park, Lexington, KY 40515. Receipt of this document is acknowledged in the listing of documents in PAIR.

The Office Action in issue here was issued by the examiner on November 1, 2007 well after the second address change had been received and made of record in the Patent Office. It addressed the correspondence (the office action) to 5522 Riva Ridge Drive, Wesley Chapel, FL 33544. Of course, this attempted correspondence was never received by the undersigned attorney at any address. The correct address of the undersigned attorney, at the time that the Office Action of November 1 was mailed, was 424 Lantana Park, Lexington, KY 40515 as set forth in the Change of Address form filed November 13, 2005. Applicant's failure to receive this action was not the fault of the undersigned attorney or the applicant but was clearly the fault of the Patent Office as it had been sent to the wrong address despite the fact that the official Patent Office file clearly indicated what the attorney's correct address should have been.

Under the circumstances, the abandonment of the above identified patent application was unavoidable because, through the exclusive fault of the Patent Office and not through any fault of applicant, applicant never received the office action of November 1, 2007. One cannot timely or otherwise reply to an office action that has never been received. It is believed that the above discussion and a review of the official Patent Office file in this matter should satisfy the requirements of 37 CFR 1.137(a)(3) and result in a finding that the abandonment was unavoidable.

On July 24, 2008 during a telephone conference with the examiner, the undersigned attorney specifically requested that the examiner immediately send a copy of this office action to him by FAX. That has not been done. A copy of this office action has been made from the file in PAIR. It has been sent to the inventor by FAX on July 25 for commentary sufficient to enable the preparation and filing of a response to the action. A response, as required under 37 CFR 1.137(a)(1), will be drafted and filed as soon as possible.